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Masayuki Tsutsumi

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EXAMINER

CHEN, VIVIAN

ART UNIT

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1794

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/507,126 | Applicant(s) TSUTSUMI ET AL. | |
| | Examiner Vivian Chen | Art Unit 1794 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/3/2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 9-11 is/are rejected.
- 7) ☒ Claim(s) 5, 7 and 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 recites the limitation "slipperiness-improving layer". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4, 6, 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over:
 - (a) FUNAKI ET AL (US 5,798,172), or
 - (b) YAMASAKI ET AL (US 5,518,817), or
 - (c) YOSHINAGA ET AL (US 5,707,719);

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in view of DAVIS (US 5,037,700) or DRUSCHKE ET AL (US 4,529,772).

FUNAKI ET AL discloses oriented syndiotactic polystyrene films, wherein the films are suitable as supports of adhesive coatings. (entire document, e.g., line 30-40, col. 2; line 36-68, col. 4; line 1-17, col. 6)

YAMASAKI ET AL discloses oriented syndiotactic polystyrene films, wherein the films are suitable as supports of adhesive coatings. (entire document, e.g., line 5-12, col. 1; columns 3, 9; etc.)

YOSHINAGA ET AL discloses oriented syndiotactic polystyrene films, wherein the films are suitable as supports of adhesive coatings. (entire document, e.g., line 52-68, col. 4; line 56, col. 5 to line 30, col. 6; line 54-62, col. 7)

However, the references fail to explicitly disclose the recited coating.

DAVIS discloses that it is well known in the art to utilize water dispersible compositions comprising a copolymer comprising at least 60 wt% acrylate monomers and up to 39 wt% styrene as an adhesive coating, wherein the adhesive has a typical bond strength of 850 lb/in or more, in order to form useful adhesive articles. (line 60, col. 2 to line 5, col. 3; line 65-68, col. 6; Example 1)

DRUSCHKE ET AL discloses that it is well known in the art to utilize water dispersible compositions comprising a copolymer comprising 50-99 wt% acrylate monomers and up to 50 wt% styrene as an adhesive coating, wherein the adhesive has a typical bond strength of 0.6 N/2 cm or more, in order to form useful adhesive articles. (line 18-46, col. 2; line 5-12, col. 2; Table 2)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply known adhesive water-based coatings to the films of FUNAKI ET AL or YAMASAKI ET AL or YOSHINAGA ET AL in order to form highly adherent adhesive articles. One of ordinary skill in the art would have used conventional additives (e.g., crosslinking agents, coupling agents, antistatic agents, etc.) to maintain high cohesion and adhesion in wet environments (claim 4) and/or improve electrical conductivity (claim 5) for static-sensitive applications. Regarding claim 9, the recited coating steps is a product-by-process limitation and is not further limiting in as so far as the structure of the product is concerned. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. ***The patentability of a product does not depend on its method of production.*** If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." [emphasis added] *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP 2113. Once a product appearing substantially identical is found, the burden shifts to applicant to show a ***unobvious*** difference between the claimed product and the prior art product. *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1993).

3. Claims 1-2, 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over:
OKADA ET AL (US 5,775,028);
in view of FUNAKI ET AL (US 5,798,172), or YAMASAKI ET AL (US 5,518,817), or
YOSHINAGA ET AL (US 5,707,719);

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and in view of DAVIS (US 5,037,700) or DRUSCHKE ET AL (US 4,529,772).

OKADA ET AL discloses oriented syndiotactic polystyrene films wherein the films further contain 0.5-10 wt% of a styrene/olefin block or graft elastomer (e.g., styrene-butadiene-styrene copolymer, etc.) However, the reference fails to explicitly disclose the recited coating.

FUNAKI ET AL discloses that it is well known in the art to use oriented syndiotactic polystyrene films as supports of adhesive coatings. (FUNAKI ET AL, entire document, e.g., line 30-40, col. 2; line 36-68, col. 4; line 1-17, col. 6) YAMASAKI ET AL discloses that it is well known in the art to use oriented syndiotactic polystyrene films as supports of adhesive coatings. (YAMASAKI ET AL, entire document, e.g., line 5-12, col. 1; columns 3, 9; etc.) YOSHINAGA ET AL discloses that it is well known in the art to use oriented syndiotactic polystyrene films as supports of adhesive coatings. (YOSHINAGA ET AL, entire document, e.g., line 52-68, col. 4; line 56, col. 5 to line 30, col. 6; line 54-62, col. 7)

DAVIS discloses that it is well known in the art to utilize water dispersible compositions comprising a copolymer comprising at least 60 wt% acrylate monomers and up to 39 wt% styrene as an adhesive coating, wherein the adhesive has a typical bond strength of 850 lb/in or more, in order to form useful adhesive articles. (line 60, col. 2 to line 5, col. 3; line 65-68, col. 6; Example 1)

DRUSCHKE ET AL discloses that it is well known in the art to utilize water dispersible compositions comprising a copolymer comprising 50-99 wt% acrylate monomers and up to 50 wt% styrene as an adhesive coating, wherein the adhesive has a typical bond strength of 0.6 N/2 cm or more, in order to form useful adhesive articles. (line 18-46, col. 2; line 5-12, col. 2; Table 2)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply known adhesive water-based coatings to the oriented films of OKADA ET AL in order to form highly adherent adhesive articles. One of ordinary skill in the art would have used conventional additives (e.g., crosslinking agents, coupling agents, antistatic agents, etc.) to maintain high cohesion and adhesion in wet environments (claim 10). It would have been obvious to adjust the amount of impact-modifying copolymer additive in the film in order to obtain the impact strength required for specific applications (claim 11).

Response to Arguments

4. Applicant's arguments filed 12/3/2007 have been fully considered but they are not persuasive.

(A) Applicant argues that DAVIS and DRUSCHKE fail to disclose the claimed invention because they disclose adhesive compositions and not “adhesiveness-improving” layers. However, in lieu of any explicit definition to the contrary, the term “adhesiveness-improving” encompasses any material which provides increased adhesion (e.g., an adhesive material).

MPEP 2111 [R-5] Claim Interpretation; Broadest Reasonable Interpretation

CLAIMS MUST BE GIVEN THEIR BROADEST REASONABLE INTERPRETATION

During patent examination, the pending claims must be “given their broadest reasonable interpretation consistent with the specification.” >The Federal Circuit’s en banc decision in *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005) expressly recognized that the USPTO employs the “broadest reasonable interpretation” standard: The Patent and Trademark Office (“PTO”) determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction “in light of the specification as it would be interpreted by one of ordinary skill in the art.” *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364[, 70 USPQ2d 1827] (Fed. Cir. 2004).

MPEP 2111.01 [R-5] Plain Meaning

I. THE WORDS OF A CLAIM MUST BE GIVEN THEIR “PLAIN MEANING” UNLESS SUCH MEANING IS INCONSISTENT WITH THE SPECIFICATION

****>** Although claims of issued patents are interpreted in light of the specification, prosecution history, prior art and other claims, this is not the mode of claim interpretation to be applied during examination. During examination, the claims must be interpreted as broadly as their terms reasonably allow. In re American Academy of Science Tech Center, 367 F.3d 1359, 1369, 70 USPQ2d 1827, 1834 (Fed. Cir. 2004) (The USPTO uses a different standard for construing claims than that used by district courts; during examination the USPTO must give claims their broadest reasonable interpretation >in light of the specification<.). This means that the words of the claim must be given their plain meaning unless ****>**the plain meaning is inconsistent with< the specification. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (discussed below); Chef America, Inc. v. Lamb-Weston, Inc., 358 F.3d 1371, 1372, 69 USPQ2d 1857 (Fed. Cir. 2004) (Ordinary, simple English words whose meaning is clear and unquestionable, absent any indication that their use in a particular context changes their meaning, are construed to mean exactly what they say. Thus, “heating the resulting batter-coated dough to a temperature in the range of about 400oF to 850oF” required heating the dough, rather than the air inside an oven, to the specified temperature.). ******

Allowable Subject Matter

5. Claims 5, 7-8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record fails to disclose or suggest an oriented syndiotactic polystyrene film having an adherent layer, wherein: (1) the adherent layer comprises the recited polystyrene sulfonate salt (claim 5); (2) the film further comprises the recited slip layer (claim 7-8).

Conclusion

1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivian Chen whose telephone number is (571) 272-1506. The examiner can normally be reached on Monday through Thursday from 8:30 AM to 6 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano, can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

The General Information telephone number for Technology Center 1700 is (571) 272-1700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

March 14, 2008

/Vivian Chen/

Primary Examiner, Art Unit 1794